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Steven J. Elleman
41,733
Reg. No.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of

Applicant : McCown et al.
Serial No. : 09/057,313
Filed : April 8, 1998
Title : CONTAINER TRANSPORTATION SYSTEM AND METHOD
Docket : 033449-002
Examiner : McAllister
Art Unit : 3652

Commissioner of Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

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This paper is filed in response to the Office action mailed on November 4, 2003. Review and reconsideration are requested in light of the comments below.

Initially it is noted that the Declaration filed on October 1, 2003 was apparently not considered during the formulation of the Office action of November 4, 2003, as the Office action does not appear to include any discussion of such a Declaration. The PAIR system indicates that the Declaration was received by the Office on October 3, 2003. Accordingly, reconsideration of the rejection in light of the Declaration and the arguments accompanying the Declaration are

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requested. Should the Office require another copy of the Declaration mailed on October 1, 2003, the Office is invited to call the undersigned.

Claims 16-19, 27, 28, 33, 37-40 and 42-44 are rejected as allegedly defining obvious subject matter over U.S. Pat. No. 4,325,667 to Freeman in view of the Kalmar web site (cited in the Office action of April 3, 2003) and in view of U.S. Pat. No. 3,691,595 to Backteman et al. The Office action takes the position that it would have been obvious to one of ordinary skill in the art to modify the method of the Freeman reference to use the reach stacker and containers of the Kalmar reference to arrive at the claimed invention. The proposed motivation for the combination is that the combination would protect the shipped product from moisture.

Applicant has argued that even if the proposed modification (and in particular the combination of the Freeman and Kalmar reference) were to be made the claimed invention would not result. Applicant has also argued that one of ordinary skill in the art would not be motivated to combine the Freeman and Kalmar references in the proposed manner because the resultant system would be inoperable. Finally, applicant has argued that the Office action does not provide a proper motivation for the proposed combination of the Freeman and Kalmar references.

Turning to the first two of the arguments, applicant has argued that the proposed modification would not result in the claimed invention, and would not be made by one of ordinary skill in the art due to the disparate natures of the systems of the Freeman and Kalmar references. In particular, applicant has argued that a system of the proposed combination would be inoperable because the structure of the Freeman reference would not be able to accommodate the reach stacker of the Kalmar reference due to differences in size, dimensions, load-bearing characteristics, etc.

In the "Response to Arguments" section the Office action indicates that the modification of the Freeman reference to use support structures capable of supporting the reach stacker and its load is "inherent," and that one of ordinary skill in the art would use appropriately scaled supports. The Office action also indicates that the containers of the Kalmar reference are not

used to teach a particular size of containers, but are included merely to teach an enclosed container.

However, it is submitted that if the Office action proposes a modification of the system of the Freeman reference (for example, including a widened ramp, a strengthened ramp, strengthened deck, and more stable arrangement of the vessel, etc.) the Office action must first make a proper obviousness rejection (i.e., indication of where the limitations can be found in the prior art, motivation for the proposed modification, etc.). Indeed, if the Freeman reference were to be modified in this manner, essentially no structure of the Freeman reference would remain, as the vessel and ramp (the only components of the Freeman reference which are utilized in the rejection) would not longer remain in their original form. Indeed, it is submitted that a rejection on the basis that a modification is "inherent" is contrary to the requirements for a proper obviousness rejection. Although anticipation by inherency (as in MPEP §2112) can be proper in certain circumstances, it is submitted that an obviousness rejection which relies upon an "inherent" modification is not proper.

In fact, these very issues involving the ramp, the deck and the configuration of the vessel of the Freeman reference highlight the novelty and patentability of the present invention. Prior to this invention, cranes (either loaded on a ship or located on shore) were used to load and unload containers onto the vessels. These cranes either stayed ashore or traveled with the ship. Reach stackers were "land based" vehicles which shuttled the containers to other vehicles (i.e., rail cars, tractor-trailers, etc.) or to locations where the containers could be lifted and transported by cranes.

Although the invention may appear, on its face, to be a relatively simple invention, from a technological standpoint, it is submitted that Applicants have invented a method which is in fact novel and nonobvious, and resulted from creative and nontraditional thinking to cross the "invisible barrier" for reach stackers. Various considerations, including providing a wide, reinforced ramp, reinforced deck, and a highly stable configuration to the barge had to be addressed by the applicants.

Furthermore, each of independent claims 16, 22 and 25 specify that the ramp has sufficient strength to support the vehicle when the vehicle is transporting a fully loaded container. Claims 16, 22 and 25 also each specify that the storage deck has sufficient strength to support the vehicle when the vehicle is transporting a fully loaded one of the containers. None of the prior art references cited in the Office action disclose the specific limitations of claims 16, 22 and 25. Instead, the Office action appears to rely upon an "inherent" argument based upon a combination of the Freeman and Kalmar references to arrive at the claimed invention. However, it is difficult to perceive how this claim limitation can be shown when neither of the cited references discloses such a claim feature. Although the Office action argues that it would have been inherent to modify the ramp, deck and vessel to support the fully loaded containers, it could be argued with equal force that it would have been "inherent" to reduce the size of the containers so that such support or reinforcement would not be necessary.

The Office action also indicates that the Kalmar reference is not used to "teach a particular size of container." Thus, this statement supports the argument that if the Kalmar and Freeman references were to be combined, it would not necessarily be "inherent" to modify the ramp and vessel in the manner proposed in the Office action, and instead the size of the containers could be reduced.

Furthermore, applicant does not necessarily agree with the statement in the Office action that the Kalmar reference is not used to teach a particular size of container. Instead, the containers of the Kalmar reference are used as, and form the basis of, an obviousness rejection. Thus, the containers of the Kalmar reference must be carried over in a "as is" condition. If, for some reason, the Office action proposes modifying the size of the containers of the Kalmar reference, it is submitted that the Office must make an obviousness rejection (i.e., cite a secondary reference, provide a motivation for the proposed modification, etc.). If no change in the condition of the containers of the Kalmar reference is proposed, it is submitted that the containers of the Kalmar reference must be taken in their form as disclosed in the cited references.

It is also submitted that the Office action does not include a proper motivation for the proposed combination of references. The proposed motivation for the proposed modification is to "protect the shipped product from moisture." However, it is submitted that if one of ordinary skill in the art wished to protect the pallets of the Freeman reference from moisture, such worker would simply locate a tarp over the goods, or encase the goods in shrink wrap, etc. It is submitted that a worker would not carry out the modification proposed in the Office action, which involves 1) discarding the pallets of the Freeman reference; 2) discarding the forklift trucks; 3) bringing in large containers; 4) bringing in reach stackers to handle such containers; 5) strengthening the ramp; 6) strengthening the deck of the barge; and 7) re-configuring the barge to make it more stable in the lateral direction, all in the name of "protecting from moisture." Instead, there are much other easier, more logical steps a worker would take to protect the shipped goods from moisture such as the use of plastic wrap (see MPEP §2143.01, citing to *In re Ratti*, 270 F.2d 810 (CCPA 1959) in which the court reversed the rejection of the claims on the basis that the proposed combination would "require a substantial reconstruction and redesign" of the components of the primary reference).

It is submitted that these somewhat convoluted steps proposed in the Office Action used to "protect from moisture" may result from use of applicant's disclosure as a template to reconstruct applicant's invention. It is noted that the reach stackers of the Kalmar reference are all shown working adjacent to barges, and loading containers onto and from the barges. However, none of the photographs show the reach stackers driven onto a barge, and the Office has to date not produced any references that show a reach stacker being driven onto a vessel or barge for loading operations.

Thus, besides the fact that the Freeman and Kalmar references cannot be combined to arrive at the claimed invention, it is respectfully submitted that the Office action has not provided sufficient motivation for the proposed combination of the Freeman and Kalmar references.

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Thus, in sum, in view of the foregoing arguments and evidence submitted in the Declaration, it is submitted that the claims define over the cited reference and that the application is in a condition for allowance, and a formal notice thereof is requested.

The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or to credit any overpayment to Deposit Account 20-0809. Applicant hereby authorizes the Commissioner under 37 C.F.R. §1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension.

Respectfully submitted,



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Application Number 09/057,313

Filing Date April 8, 1998

First Named Inventor McCown et al.

Art Unit 3652

Examiner Name McAllister

Attorney Docket Number 033449-002

Total Number of Pages in This Submission

7

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Signature *[Signature]*

Date 2/4/04

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